Serial No. 09/938,550

# REMARKS

## STATUS OF THE CLAIMS

In accordance with the foregoing, claims 1, 2, 5, and 8-14 have been amended. Claims 1-14 are currently pending and under consideration. No new matter is being presented, and approval and entry are respectfully requested.

# ENTRY OF RESPONSE UNDER 37 C.F.R. §1.116

Applicants request entry of this Rule 116 Response and Request for Reconsideration because the amendment of claims 1, 2, and 8-14 should not entail any further search by the Examiner since no new features are being added or no new issues are being raised, and these amendment) do not significantly alter the scope of the claims and place the application at least into a better form for appeal.

The Manual of Patent Examining Procedures sets forth in §714.12 that "[a]ny amendment that would place the case either in condition for allowance or in better form for appeal may be entered." (Underlining added for emphasis) Moreover, §714.13 sets forth that "[t]he Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

# REJECTION UNDER 35 U.S.C. §102(e)

In the Office Action at page 3, claims 1-14 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Publication No. 2002/0023132 to <u>Tornabene et al.</u> Claims, claims 1, 5, and 8-14 are independent claims. This rejection is traversed and reconsideration is respectfully requested.

Independent claim 7 is directed to a shared information processing system. In relevant part, a client of the shared information processing system of claim 7 includes "highlighted file name extraction means for extracting file names that can be registered as highlighted files from a chat character string inputted by a user within a channel" and "highlighted file registration determination means for determining whether or not a file corresponding to an extracted file name is to be registered as a highlighted file".

At page 10, the Office Action contends that <u>Tornabene et al.</u> teaches these features, and paragraphs 0048, 0070, 0059-0064, 0077, and 0083 are cited in support of this contention. Applicants respectfully disagree.

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Serial No. 09/938,550

Tornabene et al. is directed to systems and techniques for sharing information among members of a group, where information about all current members of a group is stored, and instructions are received from at least one current member to invite at least one prospective member to join the group. An invitation is sent to the prospective member. If the prospective member accepts the invitation, they are added to the current members of the group, and automatically updated services are provided to current members of the group.

Paragraph 0048 of Tornabene et al. merely teaches a relationship between a server and a client that are connected to a network.

Paragraph 0070 of Tornabene et al. merely teaches that each group member initializes or receives a message from a group member, so that a record of a group communications is created. These messages may be sent/received through an IM server, the Internet, or other communication servers.

Paragraphs 0059-0064 of Tornabene et al. teach only a method to perform an alert notification using an IM server.

Paragraph 0077 of Tornabene et al. merely teaches that group owners can edit settings, such as homepages, edit group titles, edit descriptions, invite new members, change the statuses of group members, remove group members, etc.

Paragraph 0083 of Tornabene et al. merely teaches that a notification is sent to the members of a group informing the group of the statuses of the members.

Thus, Tomabene et al. teaches only a method for sending notification to each member of a group, using an IM server, updating the group members regarding the status of other group members. Applicants respectfully submit that Tornabene et al. neither teaches nor suggests "highlighted file name extraction means for extracting file names that can be registered as highlighted files from a chat character string inputted by a user within a channel" or "highlighted file registration determination means for determining whether or not a file corresponding to an extracted file name is to be registered as a highlighted file", as recited by independent claim 7. Accordingly, Applicants respectfully submit that independent claim 7 patentably distinguishes over the prior art and is in condition for allowance.

As independent claims 1, 5, and 8-14 have been amended to recite features similar to those of independent claim 7, Applicants respectfully submit that claims 1, 5, and 8-14, and those claims depending directly or indirectly therefrom, patentably distinguish over the prior art and are, therefore, in condition for allowance.



Serial No. 09/938,550

## CONCLUSION

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited. At a minimum, this Amendment should be entered at least for purposes of Appeal as it either clarifies and/or narrows the issues for consideration by the Board.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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Date: W March 200

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> CERTIFICATE OF FACSIMILE TRANSMISSION I hereby certify that this correspondence is being transmitted via facsimile to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on MC4-CA 20 , 2006

STAAS & HALSEY

Date